

**REMARKS**

The Office Action mailed on April 28, 2006, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-32 were pending, with claims 15-24, and 31 being withdrawn. By this paper, Applicants cancel claims 15-25 and 31-32, without prejudice or disclaimer, and add claims 33-45. Therefore, claims 1-14, 26-30, and 33-45 are now pending.

Applicants respectfully submit that the present application is in condition for allowance for at least the reasons that follow.

**Indication of Allowable Subject Matter**

Applicants thank Examiner Bowers for the indication that claims 7 and 26 contain allowable subject matter. Applicants have placed these claims into independent form in reliance on this indication.

**Claim Objections**

In the Office Action, method claims 26-30 are objected to as erroneously being dependent from an apparatus claim. As seen above, Applicants have amended claim 26 to recite the recitations of claim 25, and have amended claims 27-30 to depend from claim 26. Applicants thank Examiner Bowers for examining these claims under the correct assumption that the claims should depend from claim 25.

In the Office Action, claims 14 and 28 are also objected to. Applicants have amended these claims to remove the offending trademark, without prejudice or disclaimer, and respectfully submit that the rejection of these claims is now moot.

**Rejection of the Claims Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claims 1 and 26 are rejected under 35 U.S.C. § 112, 2nd paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In order to advance prosecution, and without prejudice or disclaimer, Applicants have amended these claims as seen above, and respectfully request reconsideration.

**Double Patenting**

Claims 1, 2, 5, 9, 10, 12, 25, 27, 29 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting in view of co-pending Patent Application No. 10/852,684. Applicants note that Patent Application No. 10/852,684 is not yet an issued patent. Applicants acknowledge the double patenting rejection, and submit that no further response is necessary, as Patent Application No. 10/852,684 is not yet an issued patent.

Applicants cite MPEP § 804(I.B) (which defines provisional rejections), as supporting their actions, and expect that the double patenting rejection will be withdrawn from this application in the event that this application issues as a patent prior to the issuance of the cited copending applications. Applicants reserve their right to traverse the rejection at a later date.

**Rejections Under 35 U.S.C. § 102**

Claims 1, 2, 5, 6 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schramm (United States Patent No. 5,935,864), and claims 1, 2, 5 and 8-10 are rejected under 35 U.S.C. §102(e) as being anticipated by DiCesare (United States Patent Application No. 20020001539). In response, Applicants amend claim 1 without prejudice or disclaimer, in order to advance prosecution, and respectfully submit that the above claims are allowable for at least the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Section 103 amplifies the meaning of this anticipation standard by pointing out that anticipation requires that the claimed subject matter must be “*identically* disclosed or described” by the prior art reference. (Emphasis added.) It is respectfully submitted that neither Schramm nor DiCesare teach each and every element of any of the claims.

**Schramm:** Claim 1, now and prior to the above amendments, recites a swab that includes a stabilized reagent in a chamber. Schramm does not teach this recitation. Instead, Schramm teaches a device that utilizes a capillary 3 having an open capillary end. (See Schramm, col. 3, lines 24-27.) Thus, Schramm does not anticipate claim 1 even without the above proffered amendments to claim 1.

Moreover, claim 1 recites a wand assembly including a buffer container containing a buffer at an end of a shaft. The alleged buffer container is not at an end of a shaft. Thus, Schramm does not anticipate claim 1 for another reason.

**DiCesare:** Claim 1, as amended, recites a wand assembly including a buffer container containing a buffer at an end of a shaft. As correctly acknowledged in the Office Action, DiCesare does not teach a container containing a buffer. Moreover, DiCesare does not teach a device suitable for containing a buffer to usefully enable a reaction. Claim 1 is allowable for at least this reason, but there is more.

Claim 1 also recites that the apparatus is adapted to direct the buffer from the buffer container and into the chamber containing the stabilized reagent. The Office Action asserts that element 36 is a container that may hold a buffer and asserts that element 23 is the chamber that may hold the stabilized reagent. Assuming *arguendo* that this is the case, the device of DiCesare is not adapted to direct any alleged buffer contained in element 36 into element 23. Indeed, just the opposite appears to be the case, as the material in element 23

appears to be directed into element 36. Thus, yet another feature of claim 1 is not present in DiCesare. Reconsideration is requested.

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Because neither Schramm nor DiCesare teach each and every element of claim 1, these claims do not and cannot anticipate the claims that depend from claim 1. Reconsideration of the claims rejected as anticipated is requested.

**Claim Rejections Under 35 U.S.C. §103(a)**

In the Office Action, claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schramm by itself, claim 3 is rejected in view of the combination of Schramm and Wickstead (U.S. Patent No. 6,634,243). Claims 10, 25, 27 and 32 are rejected in view of the combination of Schramm with DiCesare, while claim 11 is rejected in view of this combination when further combined with Mennen (U.S. Patent No. 4,562,043). Claims 12, 13, 29 and 30 are rejected in view of the Schramm and DiCesare combination, when further combined with Berke (U.S. Patent No. 5,084,045). Claims 14 and 28 are rejected in view of the combination of Schramm, DiCesare and Sangha (U.S. Patent Application No. 20030113906). In order to advance prosecution, Applicants cancel claim 25 and amend claim 26 to include the recitations of claim 25, and amend the dependencies of claims 27-30 to depend from claim 26 (a claim indicated as being allowable), and respectfully submit that the remaining claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still cannot meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As detailed above, neither Schramm nor DiCesare teach each element of claim 1, and, therefore, do not teach each and every element of any claim that depends therefrom. As it has not been argued that any of the cited references are combinable in a manner that would remedy the above-identified deficiencies of these references with respect to claim 1, no claim that depends from claim 1 is obvious for at least this reason.

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied with respect to the cited references, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

Lack of Suggestion or Motivation to Modify or Combine the References

MPEP § 2143.01, subsection 6 states that “the proposed modification cannot change the principle of operation of a reference – If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).” In *Ratti*, the CCPA held that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference.” This substantial redesign would have resulted in changing a rigid seal to a resilient seal. Thus, a reference cannot be modified to

render an invention obvious if the modification changes a principle of operation of the reference.

With the above in mind, with respect to at least claims 10, 11, 12, 13, 14, 25, 27, 28, 29, 30 and 32, which are rejected in view of the combination of Schramm and DiCesare, it is respectfully submitted that because the teachings of Schramm rely on the use of a capillary, and DiCesare relies on an absorbent swab, modifying Schramm to utilize the absorbent swab of DiCesare would change the principle of operation of Schramm. Because modifying Schramm to include an absorbent swab changes the principle of operation of Schramm, just as changing the rigid seal to a resilient seal was found to change the principle of operation in *Ratti*, “the teachings of [Schramm] are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, emphasis added.) At least no claim rejected in view of the combination of Schramm and DiCesare is obvious.

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In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

**New Claims**

As seen above, Applicants have added new claims 33-45. These claims are allowable for at least the pertinent reasons detailed above.

Support for these claims may be found, among other places, in the claims as originally pending.

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Bowers is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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 27 Jan 06


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Respectfully submitted,

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